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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/071,985	02/07/2002	Toshifumi Murata	02073/LH	1592

7590 11/07/2005
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EXAMINER

PHAN, MAN U

ART UNIT	PAPER NUMBER
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2665

DATE MAILED: 11/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/071,985

Applicant(s)

MURATA, TOSHIFUMI

Examiner

Man Phan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,6 and 9-12 is/are rejected.
- 7) ☒ Claim(s) 2-4,7 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/9/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The application of Murata for the "Telephone system for allowing access to both telephone network and computer communication network" filed 02/07/2002 has been examined. This application claims Foreign Priority based on the application 2001-39759 filed February 16, 2001 in Japan. Receipt is acknowledged of papers submitted under 35 U.S.C 119(a) – (d), which papers have been placed of record in the file. The preliminary amendment filed 02/07/2002 has been entered and made of record. Claim 4 has been amended and new claim 12 has been added. Claims 1-12 are pending in the application.

Claim Objections

2. Applicant is advised that should claim 4 be found allowable, claim 12 will be objected to under 37 CFR 1.75 as being a substantial duplicated thereof. Appropriate correction is required.

Claim Rejections - 35 USC ' 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 5, 9, 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng et al. (US#6,424,647) in view of Umansky et al. (US#6,868,080).

With respect to claims 1, 5, 9, 10, Ng et al. (US#6,424,647) and Umansky et al. (US#6,868,080) disclose a novel system and method for allowing access to both public telephone network (PSTN) and a computer communication network (IP), according to the essential features of the claims. Ng discloses in Figs. 1-9 and in the respective portions of the specification about the voice over internet protocol device ("internet phone terminal") capable of auto-selectively dialing up a public switched telephone network or an internet phone (For example see Figs. 1-2; the Abstract), which comprises the line transfer switch ("internet phone" or "relay" in Figs. 1-2 and 8), which connects with the terminal apparatus to receive the voice signal produced by the terminal apparatus ("phone"); a control circuit ("internet processor" in Fig. 2) is used to control each component in the entire device, and proceeds with packet processing for the signal received to produce the corresponding internet protocol packet (For example see col. 4, lines 54-64); the control circuit connecting with the line transfer switch to produce a trigger signal ("ringing signal"; For example see col. 17, lines 23-30) that causes the line transfer switch to transfer the voice signal produced by the terminal apparatus from the subscriber line interface circuit ("SLIC" in Figs. 2 and 8) to the public switched telephone network (PSTN). Wherein the subscriber line interface circuit is connected to the line transfer switch and to the control circuit and arranged to transform the voice signal transmitted from the terminal apparatus to digital signal, and then transmit the digital signal to the control circuit to proceed with packet processing (For example see col. 4, lines 54-64); the phone detection circuit ("off-hook detector" in Fig. 8), which is connected with the line transfer switch and the

control circuit to detect the employment status (“on hook” in Fig. 9; it is obvious that the “off hook” position of the phone is the “unused status” of the phone) of the terminal apparatus (For example see col. 18, lines 58-62); the ringing detection circuit (“ring detector” in Fig. 8), which is connected with the line transfer switch and the loop (“position 1” in Fig. 8) to detect the incoming call ringing signal (“ringing signal”) transmitted from the public switched telephone network through the loop (For example see col. 17, lines 23-26), wherein when the incoming call ringing signal is detected according to the employment status of the terminal apparatus detected by the phone detection circuit, the control circuit supplies an incoming call transfer signal to cause the line transfer switch to connect the terminal apparatus with the loop to receive the ringing signal when the employment status of the terminal apparatus is unused (“on-hook state”), and when the terminal apparatus is picked up to enable communication with the remote terminal apparatus to proceed through the public switched telephone network (For example see col. 17, lines 21-64).

However, Ng does not disclose expressly the switching section for switchingly connecting the telephonic function section with either one of the telephone line signal processing section and the VoIP engine section. In the same field of endeavor, Umansky et al. (US#6,868,080) teaches in Figs 2, 3 detailed diagrams illustrated the functionality of the gateway, in which a switching section 24 for switchingly connecting to either the VoIP interface 25 or the PSTN telephony interface 21 (Col. 3, lines 42-50 and Col. 4, lines 7-20).

One skilled in the art would have recognized the need for facilitating the controlling of signal between telephone line signal processing and VoIP engine, and would have applied Umansky’s teaching of the switching between PSTN and VoIP into Ng’s novel use of the

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Internet phone connection. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to apply Umansky's voice over IP call fallback for quality of service degradation into Ng's method and apparatus for making a phone call connection over an Internet connection with the motivation being to provide a method and system for controlling the access to both PSTN and VoIP system.

5. Claims 11 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng et al. (US#6,424,647) in view of Umansky et al. (US#6,868,080) as applied to the claims above, and further in view of Thornton et al. (US#6,363,065).

With respect to claims 11 and 6, Ng et al. (US#6,424,647) and Umansky et al. (US#6,868,080) disclose the claimed limitations and features discussed in paragraph 4 above. However, these claims differ from the claims above in that the claims require the feature wherein a cost determination section for determining which communication via telephone network (PSTN) or computer communication network (VoIP) provides lower cost. In the same field of endeavor, Thornton et al. (US#6,363,065) discloses a telephony gateway for routing a telephony call through either a public-switched telephone network (PSTN) or a data network to a peer telephony gateway, based on, among other aspects, cost considerations for handling each such call and called directory numbers, monitoring quality of service (QoS) then provided through the data network and switching ("auto-switching") such calls back and forth between the PSTN and the data network, as needed, in response to dynamic changes in the QoS such that the call is carried over a connection then providing a sufficient QoS. To support auto-switching, the apparatus embeds, using call independent signaling, certain call-specific

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information, as non-standard data, within various conventional H.323 messages that transit between the paired gateways. Furthermore, for added local redundancy, this apparatus utilizes peered border elements within an H.323 administrative domain(a gateway handle and cost-effectively switch voice calls between the PSTN and data network)(Col. 4, lines 45 plus).

One skilled in the art would have recognized the need for facilitating the controlling of signal between telephone line signal processing and VoIP engine, and would have applied Thornton's VoIP telephone gateway utilizing cost determination, and Umansky's teaching of the switching between PSTN and VoIP into Ng's novel use of the Internet phone connection. Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to apply Thornton's apparatus for a VoIP telephony gateway and methods for use therein, and Umansky's voice over IP call fallback for quality of service degradation into Ng's method and apparatus for making a phone call connection over an Internet connection with the motivation being to provide a method and system for controlling the access to both PSTN and VoIP system.

Allowable Subject Matter

6. Claims 2-4, 7-8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is an examiner's statement of reasons for the indication of allowable subject matter: The closest prior art of record fails to disclose or suggest wherein the first condition is defined by a term including the fact that a predetermined specific key provided from

the non-numeric key is operated in the input key section under an off-hook state in the on-hook/off-hook operation section, wherein when detecting that the first condition is satisfied, the control section is operable for the switching section to connect the telephonic function section with the computer communication network; the second condition is defined by a term including the fact that any key other than specific key is operated in the input key section under the off-hook state in the on-hook/off-hook operation section, wherein when detecting that the second condition is satisfied, the control section is operable for switching section to connect the telephonic function section with the telephone network; and wherein the gatekeeper is adapted to determine that the first condition is satisfied, when the gatekeeper recognizes that the called end is located at a remote place, based on a key operated when the input key section is operated for making an outside call under the off-hook state of the on-hook/off-hook operation section of the terminal unit, so as to connect the terminal unit making the outside call with the local communication network close to the location of called end via the wide area computer communication network, wherein when the called end is the terminal unit connected with the local communication network, the gatekeeper of the local communication network close to the location of the called end is adapted to connect the outside call with the terminal, and when the called end is a telephone set connected with the outside telephone network, the gatekeeper of the local communication network close to the location of the called end is adapted to connect the outside call with the outside telephone network, as specifically recited in the claims.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The Ng et al. (US#6,424,648) is cited to show the Method and apparatus for making a phone call connection over an internet connection

The Thornton et al. (US#6,665,293) is cited to show the application for VoIP telephony gateway and method for use therein.

The Stahl et al. (US#6,801,526) is cited to show the server for supporting the establishment of telephone calls through an IP network.

The Wilson (US#6,169,734) is cited to show the internet phone set.

The Shaharabani et al. et al. (US#US2001/0012285) is cited to show the Internet telephone interface system.

The Vaananen et al. (US2004/0013109) is cited to show the method of setting up a connection for calls.

The Zhang et al. (US2004/0090954) is cited to show method and apparatus for providing internet call waiting with VoIP.

The Dolan et al. (US2005/0207557) is cited to show the methods and apparatus for providing expended telecommunications service.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. Phan whose telephone number is (571) 272-3149. The

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examiner can normally be reached on Mon - Fri from 6:00 to 3:00.

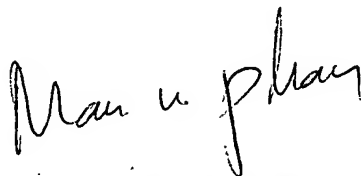
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy Vu, can be reached on (571) 272-3155. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2600.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at toll free 1-866-217-9197.

Mphan

11/03/2005.

A handwritten signature in black ink that reads "Man u phan". The signature is written in a cursive, slightly slanted style.

**MAN U. PHAN
PRIMARY EXAMINER**